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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MITCHELL, JASON D

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,111

Applicant(s)

WONG ET AL.

Examiner

Jason Mitchell

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to remarks filed on 9/27/05.

At Applicant's request claims 1, 7 and 12 have been amended. Claims 1-16 are pending in this application.

Response to Arguments

Applicant's arguments on pp 5-6 with respect to the 37 USC 102(e) rejection of claims 7-11 have been considered but are moot in view of the new ground(s) of rejection.

Independent claim 7 and dependent claims 8-11 are now rejected over Rys in view of Esquibel.

Applicant's arguments on pp. 7-8 regarding the 35 USC 103(a) rejection of claims 1-6 and 8-16 have been fully considered but they are not persuasive.

In the last full paragraph on pg. 7, Applicant states:

Esquibel discloses a system and method for propagating data from one file format and analyzes whether the file can be opened by the application. To reformat the file, an executable module is launched that is either attached to the file or accessible from a resource indicator. *Esquibel*, Abstract. Although as the Examiner points out, Esquibel can parse multiple types of files and attempt to convert them to the appropriate file for use by the application the designer and user must be aware of the functions performing the conversion. If a file does not include a transfer module, the user must attach a module to the file to allow for conversion. *Esquibel*, col. 6, lines 39-52, col. 7 lines 19-54. Thus, Esquibel requires that information be included in the file that is to be translated in the form of either the translation executable itself or a reference to the location of the translation executable.

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Examiner respectfully disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Further, it is Examiners position that one of ordinary skill in the art would have found it obvious to include Esquibel's translation executables (or references to them) in Rys' converter module ('Parser 307'), which is the object responsible for the translation (col. 6, lines 16-24 'Parser 307 converts the XML data file').

In the paragraph bridging pp. 7 and 8, Applicant goes on to state:

In contrast, independent claim 1 recites, "wherein the converter module includes an extensible set of converter functions and the converter function is selected from the extensible set." This allows the designer of the executable files not have to consider what the converter modules and/or functions are performing. It also allows files to be converted at any time to any format as long as appropriate converter function is available.

Examiner respectfully disagrees. The claim language does not include a limitation 'that the designer of the executable files not have to consider what the converter modules and functions are performing', but instead simply indicates that the set of converter functions be 'extensible' as is disclosed in Esquibel (col. 4, lines 53-56).

Accordingly the rejections of claim 1 and dependent claims 2-6 are maintained. Further the rejections of claims 12-16 are maintained for similar reasons.

Claim Rejections - 35 USC § 101

Applicant's amendment was sufficient to overcome the 35 USC 101 rejection to claims 1-6, which have consequently been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,704,736 to Rys et al. (Rys) in view of US 6,662,186 to Esquibel et al. (Esquibel).

Regarding Claims 1 and 12: Rys discloses a converter module applying a converter function corresponding to the file format of each of the original files to create new files in a converted file format (col. 6, lines 16-24 'Parser 307 converts XML data file 205 into a format ... such as the document object model').

Rys does not explicitly disclose a receiving module determining a format of each of a plurality of original files but does disclose several file formats that could be used with his invention (col. 5, lines 4-17 'SGML ... graphs').

Esquibel teaches a receiving module determining a format of each of a plurality of original files (col. 4, lines 32-40 'in accordance with the recognized format ... will open the file') and an extensible set of converter functions (col. 4, lines 53-56 'These, and other, formats can be installed') from which the converter function is selected (col. 4,

lines 43-47 'the appropriate file conversion intermediary') in an analogous art for the purpose of providing access to various file formats (col. 1, lines 61-62 'propagating data saved in one file format to another file format').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include an extensible set of converter functions (Esquibel col. 4, lines 43-56) in Rys' converter function (col. 6, lines 16-24 'Parser 307') to make Rys' invention functional with legacy systems that may be using different or older data formats (Esquibel col. 1, lines 35-41 'A file format ... that was popular just a few years ago may be completely out or vogue today').

Regarding Claims 2, and 13: The rejections of claims 1 and 12 are incorporated, respectively; further Rys discloses an application program to access information in the new files (col. 6, lines 16-24 'into a format that is capable of being ... processed by query processor 311'), and the application program is compatible with the new files and incompatible with the original files (col. 6, lines 16-24 'into a format that is capable of being ... processed by query processor 311').

Regarding Claim 3, 10 and 14: The rejections of claims 1, 7 and 12 are incorporated, respectively; further Rys discloses the converted file format is a document object model tree (col. 6, lines 16-24 'XML data file 205 is stored in ... (DOM) format').

Regarding Claim 4: The rejection of claim 1 is incorporated; further Rys discloses the converter function includes a text parser (col. 5, line 50 'Parser 307 processes XML data file 205').

Regarding Claim 5: The rejection of claim 1 is incorporated; further Rys discloses the original files include a configuration file (col. 5, lines 53-55 'stores the processed XML data in active store 309'). Rys' original files ('XML data file') initialize and 'configure' the data upon which the Application ('Query processor') works, and therefore can be considered a configuration file.

Regarding Claim 6: The rejection of claim 1 is incorporated; further Rys does not explicitly disclose determining file format based on file extensions.

Esquibel teaches the receiving module determines the format of the original files based on file extensions (col. 4, lines 32-40 'format as determined by the file extension associated with the file').

Regarding Claim 7: Rys discloses an application module to perform functions, the application module uses information contained in a configuration file to perform the functions (col. 6, lines 47-52 'Query processor 311 ... processes the image of XML data file 205 ... and returns rowset 207'); and a conversion module applying a converter function to the configuration file to convert the configuration file from a first format incompatible with the application module to a second format compatible with the application module (col. 6, lines 16-24 'Parser 307 converts XML data file 205 into a format ... such as the document object model'),

Rys inherently discloses that the application program is compatible with the new files and incompatible with the original files. If Rys' application ('query processor') were compatible with the original files ('XML data file') it would not be necessary to convert

them (col. 6, lines 16-24 'into a format that is capable of being ... processed by query processor 311').

Rys does not explicitly disclose the conversion module including an extensible set of converter functions from which the converter function is selected.

Esquibel teaches an extensible set of converter functions (col. 4, lines 53-56 'These, and other, formats can be installed') from which the converter function is selected (col. 4, lines 43-47 'the appropriate file conversion intermediary') in an analogous art for the purpose of providing access to various file formats (col. 1, lines 61-62 'propagating data saved in one file format to another file format').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include an extensible set of converter functions (Esquibel col. 4, lines 43-56) in Rys' conversion module (col. 6, lines 16-24 'Parser 307') to make Rys' invention functional with legacy systems that may be using different or older data formats (Esquibel col. 1, lines 35-41 'A file format ... that was popular just a few years ago may be completely out or vogue today').

Regarding Claim 8: The rejection of claim 7 is incorporated; further, Rys does not explicitly disclose the conversion module includes a plurality of converter functions corresponding to a plurality of file formats, but does disclose several file formats which could be used with his invention (col. 5, lines 4-17 'SGML ... graphs').

Esquibel teaches a conversion module that includes a plurality of converter functions corresponding to a plurality of file formats (col. 4, lines 32-40 'in accordance with the recognized format ... will open the file') in an analogous art for the purpose of providing

access to various file formats (col. 1, lines 61-62 'propagating data saved in one file format to another file format').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide Rys' invention with the ability to recognize and parse various file formats as taught in Esquibel because one of ordinary skill in the art would have been motivated to make Rys' invention functional with legacy systems that may be using different or older data formats (Esquibel col. 1, lines 35-41 'A file format ... that was popular just a few years ago may be completely out or vogue today').

Regarding Claim 9: The rejection of claim 8 is incorporated; further, Rys does not explicitly disclose the conversion module includes a receiving element to determine the first format.

Esquibel teaches a conversion module that includes a receiving element to determine the first format (col. 4, lines 32-40 'in accordance with the recognized format ... will open the file')

Regarding Claim 11, 15: The rejections of claims 7 and 12 are incorporated, respectively; further Rys discloses the first format is an extensible markup language (col. 5, line 50 'XML data file 205').

Regarding Claim 16: the rejection of claim 12 is incorporated; further Rys discloses the new files are saved in one of random access memory and permanent memory (col. 6, lines 35-49 'Active store 309 ... such as ... disk drive ... DRAM').

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Mitchell
10/17/05

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